

REMARKS

Claims 4-6 and 18-23 are pending in the application. Claims 4-6 and 18-23 are rejected. No claims are allowed. No claims are amended. Reconsideration of the rejection of claims 4-6 and 18-23 is requested in view of the following remarks.

Claim Rejections – 35 U.S.C. § 102

Claims 4-6 and 23 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Laffy et al. (US 5373971). According to the Examiner, Laffy discloses a syringe capable of being used as an IV flush syringe which includes an inside surface having a contact area at the distal end of the barrel which is roughened. The “roughened” portion is alleged to be the notches or teeth formed on the inside surface of the barrel which will dig into the plunger stopper and prevent it from moving rearwardly once it has been advanced. *Referencing feature 10 of Figs. 10 and 11.* It is also alleged that this contact area has a higher coefficient of friction than the inside surface outside the contact area for frictionally engaging the stopper. Applicants respectfully traverse this basis for rejection.

It has long been the law that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In addition, for an anticipation rejection to be proper, the reference must clearly and unequivocally disclose the claimed subject matter or direct those skilled in the art to the claimed subject matter without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. *See In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008) (“But disclosure of each element is not quite enough – this court has long held that ‘[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention *arranged as in the claim.*’”) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983) (emphasis in original)).

Applicants assert that Laffy does not expressly or inherently teach the claimed roughened surface which frictionally engages the stopper, and therefore does not anticipate independent

claim 4. The Examiner has characterized the notches or teeth as providing frictional engagement of the stopper. This characterization is incorrect. Laffey describes the notches or teeth shown in Fig. 10 as being “oriented in the direction of the outlet orifice, so as to oppose any movement of the piston 4 in the opposite direction and block it in the position attained.” *Col. 8, ln. 66-col. 9, ln. 3*. The description of the notches or teeth being “oriented” in a distal direction teaches that they act as barbs which allow the piston to slide over them in the distal direction but then dig into the piston to prevent subsequent rearward motion. The description of the notches or teeth as “blocking” the piston in the position attained teaches that they create a physical barrier to prevent rearward movement. That is, the notches or teeth project into the barrel from its inside surface to create a section of the barrel which is narrower than the width of the plunger. This causes the notches or teeth to dig into the plunger and prevent its rearward movement. Both of these teachings confirm that Laffey’s notches and teeth function by physically blocking the piston.

Capturing the piston by narrowing a portion of the barrel with notches or teeth, as in Laffey, does not teach or suggest frictionally holding the stopper in a deflected position nor does it rely on a higher coefficient of friction in the contact area to prevent stopper movement as required by claim 4. Claims 5, 6 and 23 each depend ultimately from claim 4. Accordingly, claims 4-6 and 23 are not anticipated by Laffey and withdrawal of the rejection is requested.

Claim Rejections – 35 U.S.C. § 103

Claims 18-21 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Laffey et al. (US 5373971) in view of Lynn (US 5522804). Lynn is relied upon for disclosure of a flush syringe with a tip cap and flushing solution in the chamber of the syringe, wherein the flushing solution is saline. Lynn is further relied upon for disclosure of a needle assembly attached to the end of the syringe. It is allegedly obvious to modify Laffey with these features as taught by Lynn. Applicants respectfully traverse this basis for rejection.

None of the disclosures referenced in Lynn overcome the failure of Laffey to disclose frictionally holding the stopper in a deflected position or a contact area with a higher coefficient of friction to prevent stopper movement. *Prima facie* obviousness has therefore not been established with respect to claims 18-21 and withdrawal of the rejection is requested.

Claim 22 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Laffy et al (US 5373971) in view of Greenwood (US 5120314). Greenwood is relied upon for disclosure of a stopper made from rubber. It is allegedly obvious to modify Laffy with the stopper of Greenwood. Applicants respectfully traverse this basis for rejection.

None of the disclosures referenced in Greenwood overcome the failure of Laffy to disclose of frictionally holding the stopper in a deflected position or a contact area with a higher coefficient of friction to prevent stopper movement. *Prima facie* obviousness has therefore not been established with respect to claim 22 and withdrawal of the rejection is requested.

CONCLUSION

It is believed that claims 4-6 and 18-23 are now in condition for allowance, early notice of which would be appreciated. No fees are believed due with this submission. If any fees are due at this time, the Commissioner is authorized to charge Deposit Account No. 50-3329. Please contact the undersigned if any further issues remain to be addressed in connection with this submission.

Respectfully submitted,

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